

## **REMARKS**

Claims 1-61 remain pending in this application. Claims 6, 12, 35, 39 and 47 were amended in this response to address informalities and to improve form. No new matter has been introduced.

### **Drawing Objections**

The drawings were objected to as figure 1 of the replacement sheet was not labeled properly. Applicant submits a new replacement sheet that complies with this requirement. Withdrawal of the drawing objection is respectfully requested.

### **Claim Informalities**

Claims 12, 35 and 47-54 were objected to for informalities. In light of the amendments submitted above, Applicant believes these objections have been overcome. Withdrawal of the objections is respectfully requested.

### **Claim Rejections – 35 U.S.C. §112**

Claim 6 was rejected under 35 U.S.C. §112(2) for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In light of the above amendment to claim 6, Applicant traverses the rejection. Withdrawal of the rejection is respectfully requested.

Claims 1-46 and 55-61 were also rejected under 35 U.S.C. §112(2) for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action states that the rejection is premised on statements made in the reply dated September 28 2004 that “the claims include the limitations of generating the profile at a first cache engine and transmitting to a second cache engine” (12/03/04 Office Action page 3). Apparently, “this statement indicates that the invention is different from what is defined in the claims because these limitations are not present in independent claims 1, 9, 16, 24, 32, 39 and 55.” Applicant respectfully traverses.

A rejection based on the failure to satisfy this requirement is appropriate only where applicant has stated, somewhere other than in the application as filed, that the

invention is something different from what is defined by the claims. In other words, the invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which applicants regard as their invention. *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971) (MPEP 2172). While the evidence cited by the Examiner was used to reject the claims due to the usage of the term "second cache engine" instead of the term "remote location" (or "remote cache" as recited in claim 9, 16, 32 and 55), the Applicant clarifies in the arguments below that the cited art does not disclose generating a profile based on the first content and transmitting the profile to a remote location as provided in claim 1. The second paragraph of 35 U.S.C. 112 does not prohibit applicants from changing what they regard as their invention during the pendency of the application. *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971) (MPEP 2172). Accordingly, it is submitted that the rejection is improper and should be withdrawn.

### **Claim Rejections – 35 U.S.C. §101**

Claims 47-61 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Specifically, the Office has found objectionable the definition of "computer readable medium" as provided in the specification. Applicant respectfully traverses.

It is Apparent that the Office Action misinterprets the text contained in the specification. Paragraph 66 of the present specification provides the following:

The term "computer-readable medium" as used herein refers to any medium that participates in providing instructions to the processor 704 for execution. Such a medium may take many forms, including but not limited to non-volatile media, volatile media, and transmission media. Non-volatile media include, for example, optical or magnetic disks, such as storage device 709. Volatile media include dynamic memory, such as main memory 705. Transmission media include coaxial cables, copper wire and fiber optics, including the wires that comprise bus 701. Transmission media can also take the form of acoustic, optical, or electromagnetic waves, such as those generated during radio frequency (RF) and infrared (IR) data communications. Common forms of computer-readable media include, for

example, a floppy disk, a flexible disk, hard disk, magnetic tape, any other magnetic medium, a CD-ROM, CDRW, DVD, any other optical medium, punch cards, paper tape, optical mark sheets, any other physical medium with patterns of holes or other optically recognizable indicia, a RAM, a PROM, and EPROM, a FLASH-EPROM, any other memory chip or cartridge, a carrier wave, or any other medium from which a computer can read.

From this, the Office Action incorrectly equates “computer-readable medium” with “transmission media.” The above passage makes clear that “computer-readable medium” refers to any medium that participates in providing instructions to the processor for execution. One exemplary means for transmitting the instructions includes the transmission media described above. However, nowhere in the present disclosure is it remotely suggested that “computer-readable medium” and “transmission media” are one and the same.

As MPEP 2106 provides:

the applicant is in the best position to explain why an invention is believed useful. Office personnel should therefore focus their efforts on pointing out statements made in the specification that identify all practical applications for the invention. Office personnel should rely on such statements throughout the examination when assessing the invention for compliance with all statutory criteria. An applicant may assert more than one practical application, but only one is necessary to satisfy the utility requirement. Office personnel should review the entire disclosure to determine the features necessary to accomplish at least one asserted practical application.

Accordingly, the rejection under 35 U.S.C. §101 is improper and should be withdrawn.

### **Claim Rejections – 35 U.S.C. §102**

Claims 1-2, 4-10, 12-17, 19-25, 27-33, 35-40, 42-48, 50-56, and 58-61 were rejected under 35 U.S.C. § 102(e) as being anticipated by MALKIN et al. (U.S. Patent No. 6,085,193).

Claims 1-4, 7-12, 15, 24-27, 30, 32-35, 38-42, 45-50, 53-58 and 61 were rejected under 35 U.S.C. § 102(e) as being anticipated by CARNEAL et al. (U.S. Patent No. 6,282,542). Applicant respectfully traverses the rejections. Favorable reconsideration is respectfully requested.

Specifically, MALKIN et al. does not disclose or suggest “generating a profile based on first content” and “transmitting the profile to a remote location.” The Examiner relied upon col. 8, lines 38-52 for allegedly disclosing both receiving a profile and generating a master profile (12/03/04 Office Action, pg. 5). Applicant respectfully submits that this section of MALKIN et al. does not disclose or suggest generating a profile based on the first content and transmitting the profile to a remote location, as required by claim 1.

MALKIN et al. discloses (col. 8, lines 38-52) annotating prefetch hint information (PHI) to content transmitted from a content server to a proxy server and on to a client (see Figs. 2 and 3A). This PHI is utilized by the proxy server and/or client server to dynamically prefetch content (col. 3, lines 26-41). The content server initiated prefetch content is not equivalent to the profile of the present invention in that the profile is generated at a first cache engine and transmitted to a second cache engine. Col. 3, lines 46-51 indicates that inline objects are requested and retrieved separately from base components of requested documents. Accordingly, the configuration does not match the first content/second content configuration claimed herein (see additionally arguments regarding CARNEAL, below).

Additionally, MALKIN et al. does not disclose or suggest generating a master profile, retrieving second content associated with the master profile, and transmitting the second content to the remote location, as required by claim 1. Rather, the system of MALKIN et al. relies upon PHI annotated to an original response from a content server to indicate which information regarding the request may be subsequently prefetched.

For at least the reasons set forth above, Applicant respectfully submits that claim 1 is not anticipated by MALKIN et al.

Dependent claims 2 and 4-8 depend from claim 1. Accordingly, these claims are not anticipated by MALKIN et al. for at least the reasons set forth above with respect to claim 1.

Independent claims 9, 16, 24, 32, 39, 47 and 55, recite similar subject matter as that described above, with respect to claim 1. Regarding claim 9, MALKIN does not teach, among other things, generating a master profile based upon the received profile and retrieving content associated with the master profile. The initial/final PHI disclosed in MALKIN (col. 8, line 64 – col. 9, line 2) discloses that the PHI is modified as is transmitted through the proxy hierarchy. Accordingly, the master profile isn't based on the received profile, but is processed through the proxy hierarchy before being developed. This feature is similarly recited in claims 16, 24, 32, 39, 47 and 55. Accordingly, these claims are also not anticipated by MALKIN et al. for at least reasons.

Dependent claims 10 and 12-15 depend from claim 9. Dependent claims 17 and, 19-23 depend from claim 16. Dependent claims 25 and 27-31 depend from claim 24. Dependent claims 33 and 35-38 depend from claim 32. Dependent claims 40 and 42-46 depend from claim 39. Dependent claims 48 and 50-53 depend from claim 47. Dependent claims 55-56 and 58-61 depend from claim 54. Accordingly, each of these claims are also not anticipated by MALKIN et al. for at least reasons similar to those set forth above with respect to claims 9, 16, 24, 32, 39, 47 and 55.

Regarding CARNEAL et al., the reference does not disclose or suggest generating a profile based on first tier content and transmitting the profile to a second cache engine. The Examiner relied upon col. 8, lines 30-43 for allegedly disclosing a profile (12/03/04 Office Action, pg. 7). Applicant respectfully submits that this section of CARNEAL et al. does not disclose or suggest generating a profile based on the first content and transmitting the profile to a second cache engine, as required by claim 1. Instead, this section of CARNEAL et al. discloses the prefetching operation of the satellite gateway. Essentially, upon receiving a request for a parent file from a client, the satellite gateway initially forwards the request to the web server and receives the requested document. Simultaneously, the gateway examines the document for inline

objects (e.g., images, audio, etc.). The gateway then generates surrogate requests for the inline objects and caches the responses for subsequent retrieval by the client. In a conventional system, the client would need to examine the document for these objects and perform repeated queries for the objects over the network. The system of CARNEAL et al. prevents the client from needing to request the imbedded objects over the satellite link, thus increasing responsiveness. Clearly, the inline object prefetching process of CARNEAL et al. is not equivalent or does not suggest generating a profile based upon first tier content at a first cache engine, and transmitting the profile to a second cache engine, as required by claim 1.

Additionally, CARNEAL et al. does not disclose or suggest generating a master profile, retrieving second tier content associated with the master profile, and transmitting the second tier content to the first cache engine, as required by amended claim 1. Rather, the system of CARNEAL et al. performs prefetching of information directly related to a specific document request. No content profile is transmitted to a second cache engine, no master profile is generated based on the profile and no second tier content associated with the master profile is retrieved and transmitted to the first cache engine.

For at least the reasons set forth above, Applicant respectfully submits that claim 1 is not anticipated by CARNEAL et al.

Dependent claims 2-4 and 7-8 depend from claim 1. Accordingly, these claims are not anticipated by CARNEAL et al. for at least the reasons set forth above with respect to claim 1.

Independent claims 9, 24, 32, 39, 47 and 55, as amended, recite similar subject matter as that described above, with respect to claim 1. Accordingly, these claims are also not anticipated by CARNEAL et al. for at least reasons similar to those set forth above with respect to claim 1.

Dependent claims 10-12 and 15 depend from claim 9. Dependent claims 25-27 and 30 depend from claim 24. Dependent claims 33-35 and 38 depend from claim 32.

Dependent claims 40-42 and 45-46 depend from claim 39. Dependent claims 48-50 and 53 depend from claim 47. Dependent claims 55-58 and 61 depend from claim 54. Accordingly, each of these claims are also not anticipated by MALKIN et al. for at least reasons similar to those set forth above with respect to claims 9, 24, 32, 39, 47 and 55.

### **Claim Rejections – 35 U.S.C. §103**


Claims 3, 11, 18, 26, 34, 41, 49 and 57 were rejected under 35 U.S.C. § 103(a) as being unpatentable over MALKIN et al. in view of CARNEAL et al. Applicant respectfully traverses the rejections. Favorable reconsideration is respectfully requested.

The disclosure of CARNEAL et al. does not remedy the deficiencies in MALKIN et al. Accordingly, claim 3 is believed to be patentable over the combination of MALKIN et al. and CARNEAL et al. for at least reasons similar to those set forth above with respect to claim 1. Claim 11 depends from claim 9. Claim 11 is believed to be patentable over the combination of MALKIN et al. and CARNEAL et al. for at least reasons similar to those set forth above with respect to claim 9. Claim 18 depends from claim 16. Claim 18 is believed to be patentable over the combination of MALKIN et al. and CARNEAL et al. for at least reasons similar to those set forth above with respect to claim 16. Claim 26 depends from claim 24. Claim 26 is believed to be patentable over the combination of MALKIN et al. and CARNEAL et al. for at least reasons similar to those set forth above with respect to claim 24. Claim 34 depends from claim 32. Claim 34 is believed to be patentable over the combination of MALKIN et al. and CARNEAL et al. for at least reasons similar to those set forth above with respect to claim 32. Claim 41 depends from claim 39. Claim 41 is believed to be patentable over the combination of MALKIN et al. and CARNEAL et al. for at least reasons similar to those set forth above with respect to claim 39. Claim 49 depends from claim 47. Claim 49 is believed to be patentable over the combination of MALKIN et al. and CARNEAL et al. for at least reasons similar to those set forth above with respect to claim 47. Claim 57 depends from claim 55. Claim 57 is believed to be patentable over the combination of MALKIN

et al. and CARNEAL et al. for at least reasons similar to those set forth above with respect to claim 55.

In light of the above amendments and arguments, Applicants submit that claims 14-26 are allowable. Applicants respectfully submit that the patent application is in condition for allowance and request a Notice of Allowance be issued. The Commissioner is authorized to charge and credit Deposit Account No. 50-0383 for any additional fees associated with the submission of this Response. Please reference docket number PD-201082.

Respectfully submitted,

BY  3-1-2005  
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**Amendments to the Drawings:**

The attached sheet of drawings includes changes to Fig. 1 to include reference numeral 100 and a respective lead line.

Attachment: Replacement Sheet